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09/727,560	12/01/2000	Matti Salmi	442-009972-US(PAR)	6683

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EXAMINER

JUNG, MIN

ART UNIT	PAPER NUMBER
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2663

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/727,560

Applicant(s)

SALMI, MATTI

Examiner

Min Jung

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-29 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3,4.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-14 and 18-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 4, it is not clear what is meant by “a specific filtering parameter is connected ----to the electronic information”; does it mean that the parameter is associated with the electronic information?

In claim 2, line 5, it is not clear what is meant by “after this”. Further, it is not clear what the functional distinction is between the two separate steps “by informing” and “by retrieving”.

In claim 5, line 4, “said adding” lacks antecedent basis.

In claim 6, line 3, it is not clear what is meant by “after this”.

In claim 18, line 5, and claim 20, line 3, and claim 26, lines 4 and 9, the meaning of “attaching” in this case is not clear in view of the context of the rest of the claim; should it be changed to “associating”?

In claim 19, line 5, it is not clear what is meant by “after this”.

Claim Rejections - 35 USC § 103

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10, 12-15, 17-24, and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al., 6,421,707 (Miller) in view of Proust et al., 6,367,014 (Proust).

Miller discloses a wireless multi-media messaging communications method and apparatus that permits a subscriber to a wireless telecommunications services to receive and generate multimedia messages from known wireless personal communications devices.

Regarding claims 1, 14, 15, 18, and 20, in Miller, SMS notification regarding incoming email is sent to a terminal (col. 4, lines 51-54), also sent is a specific filtering parameter for the purpose of filtering before the electronic information is transferred to the terminal through the telecommunication connection (the type and size of each attachment in the email shown in Fig. 4(i), col. 5, lines 35-40). This way, the terminal is informed of the type and size parameter before the electronic information is transferred to the terminal through the telecommunication connection. The user at the terminal then checks the informed filtering parameter (type and size) and specifies which electronic information he wishes to retrieve on the basis of the filtering parameter (col. 5, lines 41-45). In response to the user's response, the electronic information is transferred to the terminal through the telecommunication connection (col. 5, line 50 – col. 6, line 40).

Miller fails to specifically teach the reception-preventing step. In Miller, the user chooses whatever information that he/she wishes to receive in whichever form (SMS data, voice, or fax, for example) whenever he/she wants it. It is inherent that if the user does not wish to receive certain information, then the user simply does not choose the certain information from the displayed parameter. In response to this 'no response', the electronic information will not be transferred to the terminal. However, as shown by Proust, acceptance or rejection determination of information at a user terminal is well known method in the field of SMS used in radio communication system. In Proust, SIM module attached to mobile station compares various parameters transmitted to the mobile station to make the determination whether to accept or reject the message. Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to implement the system of Miller to include an active step of rejection (or preventing the receiving) when the information is not desired, instead of only having the passive step of 'not choosing' when the information is not desired.

Note that the term "attaching" in claim 20 has been interpreted to mean "associating", because it is understood that the electronic information is sent separately from the filtering parameters, and therefore, the filtering parameter sent would not have the electronic information attached to it.

Regarding claims 2 and 19, Miller's teaching covers the allowing of the reception and sending the information to the terminal, and/or retrieving the electronic information, as addressed above. The preventing step is taught in Proust. The obviousness reasoning is the same as above.

Regarding claims 3, 17, and 28, it is inherent in Miller that the terminal is a battery-operated terminal (because wireless terminals are battery operated). Miller also teaches the wireless connection (Fig. 3).

Regarding claims 4 and 27, Miller teaches that the electronic information is transferred to the terminal through the telecommunication connection from a server (web server 120) or a second terminal (Radhika's terminal, col. 4, lines 20-21).

Regarding claim 5, and 21, Miller teaches that the telecommunication connection is implemented by a connection through a telecommunication network (Fig. 3, col. 3, line 66-col. 4, line 15), and the filtering parameter (type and size) is sent from the data server (col. 5, lines 34-40 and col. 9, lines 37-57, when email is received at the data server WDS, the notification and the type and size information is sent to the mobile station).

Regarding claim 6, Miller teaches separate transmission of notification message and electronic information; electronic information is transferred only if the terminal allows the receiving of the electronic information (col. 3, lines 35-36, and col. 5, lines 41-49).

Regarding claim 7, Miller does not teach sending the filtering parameter in the header part, and sending the electronic information in the base part, and receiving the base part only if the terminal allows the receiving of the information. Proust teaches that the terminal accepts or refuses the enhanced message after checking the coherence of certain values included in the message. As addressed above, Proust's teaching is in the same field of endeavor as the Miller's teaching. Therefore, it would have been obvious

for one of ordinary skill in the art at the time of the invention to implement Miller's teaching by examining a certain part in the message to decide whether to accept or reject the whole message as taught by Proust in order to handle electronic information having a smaller content more efficiently.

Regarding claims 8 and 22, Miller teaches filtering parameter comprising information on at least one class of a number of classes agreed on in advance (main body, text attachment (plain text), or graphics file (power point), col. 5, line 35 – col. 6, line 13).

Regarding claims 9 and 23, Miller teaches the information for identifying the original source of the electronic information (the sender information, Fig. 4(f), col. 5, lines 15-19).

Regarding claims 10 and 24, Miller teaches the information for identifying the content of the electronic information (Fig. 4(i)).

Regarding claim 12, Miller teaches that the filtering parameter (shown in Fig. 4(ii)) is automatically sent by the server, and is not influenced by the user terminal. This is apparent from the teaching of this information (filtering parameter) being displayed at the user terminal when user checks the incoming information. User input is put in only after the checking of the synopsis of incoming information.

Regarding claim 13, Miller fails to specifically teach specifying in advance whether the receiving is allowed or prevented on the basis of the filtering parameter. This, however, is taught by Proust, as addressed above with regard to claim 1. Proust teaches comparison of received filtering parameter with the internal status of the SIM

module to make the accept/refuse decision. It would have been obvious for one of ordinary skill in the art at the time of the invention to implement Miller's teaching with the comparison scheme taught in Proust because automatic decision by the machine would filter out unwanted data from being brought to the screen.

Regarding claim 29, the sender address information (Fig. 4(f)) reads on the class information which is added because the sender address information tells that the electronic information is a personal message.

Allowable Subject Matter

5. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 11, 25, and 26 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Alperovich et al. patent, 6,101,393, the Vo et al. patent, the Jain patent, the Alperovich patent, 6,175,743, the Dietrich patent, the Ritter et al. patent, the Comer patent, and the Havinis et al. patent, are cited for further references.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Min Jung whose telephone number is 703-305-4363.

The examiner can normally be reached on Monday-Friday, 7AM-3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on 703-308-5340. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJ
June 18, 2004


Min Jung
Primary Examiner